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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,469	12/08/2003	Heribert Lorenz	101216-38	2884

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EXAMINER	
ELHILO, EISA B	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/730,469	LORENZ ET AL.	
	Examiner	Art Unit	
	Eisa B. Elhilo	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1 A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/4/2005 has been entered.

Double Patenting

2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/465278. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the co-pending Applications No. 10/465278 teaches and discloses similar hair dyeing composition on the basis of an oxidation dyestuff precursor reacting with peroxide wherein the composition consisting of at least one developing and/or coupling substance selected from a) 3-chloro-p-aminophenol and 2-chloro-p-aminophenolcompounds, b) 3-(N-methyl-N-hydroxyethyl amino)-phenol, 3-morpholinophenol, 3-(N-hydroxyethyl amino)-

phenol and 3-(N-hydroxypropyl amino)-phenol and d) that selected from at lest one para-phenelyenediamines, 1-methoxy-2-amino-4-(β-hydroxyethyl amino)benzene or the water-soluble salts thereof. Therefore, this is an obvious formulation.

Although, claim 1 of the co-pending Applications No. 10/465,278, teaches and discloses similar hair dyeing composition, they are not identical to the instant claim, because claim 1 of the co-pending Applications No. 10/465,278, does require at least one developing and/or coupling substance selected from the group consisting of o-aminophenol and 4-chloro-2-aminophenol while the instant claims do not require at least one developing and/or coupling substance selected from the group consisting of o-aminophenol and 4-chloro-2-aminophenol to presented in the dyeing composition. Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to formulate a composition consisting of or comprising the claimed dyeing ingredients, because claim 1 of the copending Application No. 10/465,278 clearly teaches a dyeing composition includes all the dyeing ingredients as claimed, and, thus, a person of the ordinary skill in the art would be motivated to formulate such a dyeing composition with a reasonable expectation of success and would expect such a composition to have similar properties to those claimed, absent unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Audousset et al. (US 5,578,087) in view of Audousset (US 6,004,356).

Audousset et al. (US' 087) teaches a hair dyeing composition comprising at least one benzimidazole component combined with developing agents (oxidation bases) of 3-chloro-p-aminophenol (see col. 3, line 55) and para-phenylenediamine (see col. 2, lines 49-67).

Although Audoesset et al. (US' 078) teaches a hair dyeing composition comprising oxidation bases of 3-chloro-p-aminophenol and para-phenylenediamine, the reference does not teach the dyeing compounds as claimed in claim 2 b). However, the reference teaches that the dyeing composition can also contains other couplers such as the genus meta-aminophenols, which are customarily used in dyeing composition for keratinous fibers (see col. 5, lines 27-29).

Audousset (US' 356) teaches in analogous art of hair dyeing formulation, a composition comprising meta-aminophenol of a formula (I) (col. 2, formula (I)), which is read on the claimed compound 3-(N-methyl-N-hydroxylpropyl amino)-phenol when in the reference's formula (I), R1, R4 and R5 are hydrogen atoms, R2 is C1-C4 monohydroxy alkyl and R3 is an alkyl radical (see col. 2, lines 45-55).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the dyeing composition of Audousset et al. (US' 078) by incorporating the meta-aminophenol compounds as taught by Audousset (US' 356) to make such a composition with the reasonable expectation of success. Such a modification would be obvious because the primary reference of Audoussest et al. (US'

078) clearly suggests that other customarily used couplers may be included in the dyeing composition and among these couplers are the genus meta-aminophenols (see col. 5, lines 27-29). Audousset (US' 356) as a secondary reference, clearly teaches the couplers of meta-aminophenols as claimed, and, thus, a person of the ordinary skill in the art would be motivated to incorporate the meta-aminophenols as taught by Audousset (US' 356) as a customarily used coupler in the dyeing composition of Audousset et al. (US' 078) with a reasonable expectation of success for improving the dyeing properties of the composition and would expect such a composition to have similar properties to those claimed in the absence of contrary.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eisa Elhilo
Patent Examiner
Art Unit 1751

May 13, 2005